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| APPLICATION NO.       | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------|-------------|----------------------|---------------------|------------------|
| 10/521,521            | 01/18/2005  | Michael Trioano      | 104222-320-PCT      | 9142             |
| 24964                 | 7590        | 10/24/2006           | EXAMINER            |                  |
| GOODWIN PROCTER L.L.P |             |                      |                     | NGUYEN, DAVID Q  |
| 599 LEXINGTON AVE.    |             |                      |                     | ART UNIT         |
| NEW YORK, NY 10022    |             |                      |                     | PAPER NUMBER     |
|                       |             |                      |                     | 2617             |

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                             |                  |  |
|------------------------------|-----------------------------|------------------|--|
| <b>Office Action Summary</b> | Application No.             | Applicant(s)     |  |
|                              | 10/521,521                  | TRIOANO ET AL.   |  |
|                              | Examiner<br>David Q. Nguyen | Art Unit<br>2617 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 23 June 2006.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-35 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-14,21,22 and 35 is/are rejected.

7) Claim(s) 15-20 and 23-34 is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|                                                                                                                                                                                                                                                                                      |                                                                                                                                                                                                                         |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| <p>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br/>Paper No(s)/Mail Date _____.</p> | <p>4)<input type="checkbox"/> Interview Summary (PTO-413)<br/>Paper No(s)/Mail Date. _____.</p> <p>5)<input type="checkbox"/> Notice of Informal Patent Application</p> <p>6)<input type="checkbox"/> Other: _____.</p> |
|--------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|-------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 06/23/06 have been fully considered but they are not persuasive.

In response to applicant's Remarks, applicant argue: "Schiff does not disclose a system for enabling targeted content delivery to a mobile device as required by claim 1".

Examiner disagrees. Schiff discloses transmitting to the communication device 14 at least one of transaction amount, a merchant identifier, a date, a time, and a remaining balance in a financial account associated with the user (see par. 0044). Therefore, Schiff discloses a system for enabling targeted content delivery to a mobile device as required by claim 1.

Applicants also argue: " Schiff does not derive the mobile device address from the at least one unique identifier, or send generated content to the device address of the mobile device".

Examiner disagrees. Schiff discloses that user uses the point of sale 12 to enter transaction amount and a communication device access number. The system 16 contacts the communication device 14 and transmit to communication device at least one of a transaction amount, a merchant identifier, a date, a time, and a remaining balance in a financial account associated with the user (see pars. 0043-0044). Therefore, Schiff discloses deriving the mobile device address from the at least one unique identifier, or send generated content to the device address of the mobile device.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-14, 21-22 and 35 rejected under 35 U.S.C. 102(e) as being anticipated by Schiff et al. (US 2003/0074328A1).

Regarding claim 1, Schiff et al discloses a system for enabling targeted content delivery to a mobile device user (see par. 0044), said mobile device having a device address (see par. 0039, the telephone number), said device address having associated therewith at least one unique identifier (see par. 0039, the user's ID), said system comprising a message application server (see fig. 1, the system 16 with the processor 26 and memory 24); and a trigger system in communication with said message application server (see fig. 1), said trigger system comprising a trigger client component (see fig. 1, the financial transaction 12) configured to generate a trigger signal comprising a trigger action (see par. 0040, user conducts a financial transaction with the financial transaction device 12), user content request data (see par. 0040, user conducts a financial transaction with the financial transaction device 12) and said at least one unique identifier (see fig. 1, and par. 0039, the user's identify); a trigger server component in communication with said trigger client component (see fig. 1, transceiver 26 or IRV 22), said trigger server component configured to: receive said trigger signal (see par. 0035), send to said message application server said trigger signal for processing by said message application server (see fig. 1 and par. 0035, the processor 26 executes command and retrieve information from or store information to a database); wherein said message application server is configured to receive from said trigger system said trigger signal, and in response thereto derive said mobile device

address from said at least one unique identifier, generate content based on said user request data, and send said generated content to said device address of said mobile device (see fig. 1 and pars. 0035-0036, pars. 0043-0044).

Regarding claims 2-4, Schiff et al also discloses wherein said message application server further includes a message application database for storing transaction information comprising said user request data and said device address (see fig.1; its description and abstract); wherein said trigger client component is said mobile device (see fig.1; its description and abstract); wherein said trigger system comprises a client application residing on said trigger client component for generating said trigger signal; and a server application residing on said trigger server component in communication with said client application and said message application server, said server application for receiving and processing said trigger signal sent by said client application (see fig.1; its description and abstract).

Regarding claims 6-10, Schiff et al also discloses wherein said trigger client component further comprising at least one input device (see fig.1; its description and abstract); wherein said at least one input device is selected from the group consisting of a magnetic card reader, bar code reader, keyboard, keypad, touch pad, sensors, and any combination thereof (see fig.1; its description and abstract); wherein said sensors include a wireless sensor and a biometric sensor (see fig.1; its description and abstract); wherein said trigger client component is an account card and a reader and wherein said trigger signal is generated by swiping said account card through said reader and having said trigger system identify said unique identifier based on account card information (see fig.1; its description and abstract); wherein said trigger system comprises an IVR system, said mobile device is a cellular phone, said device address is a cellular phone

number and said trigger action is a voice call; said IVR system configured to process said trigger signal to acquire said cellular phone number of said cellular phone (see fig.1; its description and abstract).

Regarding claims 11-14, Schiff et al also discloses wherein said trigger system comprises a PSTN and a Phone Switch connected to said PSTN, said mobile device is a cellular phone, said mobile device address is a cellular phone number and said trigger action is a voice call; said trigger system configured to detect incoming call establishment requests from said PSTN and to process said trigger signal to acquire said cellular phone number of said cellular phone (see fig. 1); wherein said mobile device is a network-enabled device; wherein said mobile device is a cellular phone having a cellular phone number as said device address; wherein said device address is a calling number, a cellular phone number, an instant messaging address, an e-mail address or other addressing type (see fig.1; its description and abstract).

Regarding claims 21-22, Schiff et al also discloses the system further comprising at least one communications network wherein said trigger system communicates with said message application server via said at least one communications network and wherein said trigger client device system communicates with said trigger server device via said at least one communications network (see fig.1 and its description); wherein said generated content comprises a message, a coupon, an offer or a promotion (see fig.1; its description and abstract).

Regarding claim 35, Schiff et al also discloses the system comprising a mobile network in communication with said mobile device and wherein said message application server sends said generated content to said device address via said mobile network (see fig.1; its description and abstract).

***Allowable Subject Matter***

3. Claims 15-20, and 23-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, as indicated in the previous office action.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q. Nguyen whose telephone number is 571-272-7844. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOSEPH H. FEILD can be reached on (571)272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
David Q Nguyen  
Examiner  
Art Unit 2617

  
JOSEPH FEILD  
SUPERVISORY PATENT EXAMINER